

REMARKS

The Examiner has taken the position that restriction to one of four of the following groups of claims is required under 35 U.S.C. 121.

Group I: Claims 55-70, drawn to the method of making a prosthesis including one [of] the steps of rolling a desired thickness of the past[e] onto a mandrel, classified in class 623, subclass 1.13.

Group II: Claims 71-86, drawn to the method of making a prosthesis including one [of] the steps of extruding the paste through an annular orifice, classified in class 623, subclass 1.13.

Group III: Claims 87-102, drawn to the method of making a prosthesis including one [of] the steps of depositing the paste in consecutive layers onto a mandrel, classified in class 623, subclass 1.13.

Group IV: Claims 103-112, drawn to the method of making a prosthesis including the steps of extruding a thermoplastic elastomer with the aid of a blowing agent to produce a foamed graft and annealing and reticulating the foamed graft to effect an open-cell structure, classified in class 623, subclass 1.13.

The Examiner asserts the inventions are distinct, each from the other because of the following reasons:

- (1) Groups I and II, Groups I and III, Groups I and IV, Groups II and III, Groups II and IV and Groups III and IV are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions could have different modes of operation.
- (2) Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicants provisionally elect Group IV, Claims 103-112, with traverse, drawn to a method of making a prosthesis classified in class 623, subclass 1.13. Applicants have withdrawn the remaining claims, i.e., claims 55-102, without prejudice. Applicants reserve the right to file one or more divisional applications, should Applicants' request to withdraw the present Restriction Requirement not be granted.

Applicants note that in the parent application, Serial No. 09/434,649, which issued as U.S. Patent No. 6,702,848, the Examiner issued a Restriction Requirement in which method claims 30-112 were listed in a single group directed to a method of making a prosthesis and thus were deemed by the Examiner to be a single invention. Subsequently, in a first divisional application, Serial No. 09/757,527, which issued as U.S. Patent No. 6,616,699, the Examiner issued a Restriction Requirement in which claims 30-112 were divided into four groups, i.e., Group I: claims 30-54; Group II: claims 55-70 and 87-102; Group III: claims 71-86; and Group IV: claims 103-112, instead of the single group of method claims as was done in the parent application. Applicants' Representative presented the following arguments to traverse that Restriction Requirement:

MPEP § 803 states that the two requirements for restriction are:

- (1) The inventions must be independent or distinct as claimed; and,
- (2) [T]here must be a serious burden on the examiner if restriction is not required."

Applicant respectfully requests reconsideration and withdrawal of the present restriction requirement based on that the Examiner has not satisfied either of the requirements.

First, the Examiner has not given the particular reasons relied upon for holding that the inventions as claimed are either independent or distinct, as required by MPEP § 816 and expanded upon in MPEP § 808 *et seq.* Instead, a mere statement of conclusion is given. The Examiner only asserts that the claims are functionally different. A mere assertion that the claim groupings have different functions does not establish a proper base for restriction, without setting forth the factual predicate on which the assertion is based. Consequently, in order to traverse the restriction requirement, the Applicant must assume the reasons for requiring the restriction. Should the traverse of the restriction requirement contained in this response be determined inadequate to overcome the restriction requirement, the Examiner is requested to supply particular reasons for the restriction requirement as required by MPEP § 816 to allow the Applicant to identify and respond directly to each reason.

Even if the invention includes claims to distinct or independent inventions, "[i]f the search and examination of an entire application can be made without serious burden", MPEP § 803 requires that the examiner "must examine [the entire application] on the merits." The Examiner may show that an undue burden is faced by demonstrating that separate searches are required. However, that burden is rebuttable. In co-pending application, 09/434,649, recently allowed by the Examiner, the application was subject of an earlier restriction requirement, wherein product claims and process claims were subdivided. Further, a search of this subject matter was previously completed, and is available to the examiner. Having searched the product claims, it would not seem an undue burden to expand the search for the process claims because the prior search would probably have identified the most relevant prior art for the process. It would appear that what ever additional searching is required to search the process claims, it would not be an undue burden.

In the present Restriction Requirement, the Examiner has again divided the claims into four groups, but these four groups are different than the four groups identified in the first divisional application, i.e., Group I: claims 55-70; Group II: claims 71-87; Group III: claims 87-102; and Group IV: claims 103-112. The arguments made against restriction in the first divisional application (recited verbatim above) are incorporated herein and apply with equal force to the Examiner's present Restriction Requirement. Moreover, Applicants point out that the present Restriction Requirement lists the exact same class and subclass (i.e., 623 and 1.13, respectively) for all four of the Examiner's groups of claims. As a result, there can be no argument that searching all of the claims together as a single group of method claims does not pose any burden on the Examiner and certainly not an undue burden. Moreover, the Examiner's search of method claims 30-54 in the first divisional application has likely identified the most relevant prior art for the remaining method claims, i.e., 55-112.

As a result, in light of the arguments presented above, Applicants respectfully traverse the Examiner's present Restriction Requirement and request that all of the pending claims, i.e., 55-112, be searched and examined together as the Examiner originally indicated was proper in the parent application.

The Examiner is invited to contact Applicants' Representative at the below-listed telephone number if there are any questions regarding this Response or if prosecution of this application may be assisted thereby. In addition, all future communications should be directed to Applicants' Representative at the below-listed telephone number.

Respectfully submitted for

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Nov. 8, 2005

Date